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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,203	10/02/2000	Cornelius Borst	P-3875.09	3753
27581	7590	04/21/2004	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MS-LC340 MINNEAPOLIS, MN 55432-5604			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,203

Applicant(s)

BORST ET AL. *PR*

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application or a CPA assigned the same application number.

In the current case, applicant's specification states that it is a cip of 09/493,466, which is a divisional of 08/531363. However, 09/493466 is not copending with 08/531363 and is in fact a CIP of the earlier application, not a divisional. Since specific reference, as required by rule 1.78 is not made in the specification or on a data sheet to the applications in the chain between 08/531363 and 09/493466 (i.e. 09/334531 and 08/725371), applicant is not entitled to priority back to the original application, 08/531363. Accordingly, the current claims only have the benefit of priority to 09/493466, or January 28, 2000.

The examiner further notes that the current claims are drawn to the embodiment of figures 34-45. None of the prior cases support his subject matter. Hence, the current claims have only the current filing date, or 10/2/2000, even if the priority claim were corrected.

Applicant may correct the priority claim by filing a petition in accordance with 37 CFR 1.78(a)(3).

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 8-18, 22-26, 28, 30-35, 37, and 39-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Vierra et al 5,749,892. Vierra et al shows a device having an arm 43, and a mechanical actuator, knob 69, connected to one end of the arm, a spreader 51 connected to the other end of the arm and to the actuator. There are two contact members 15 and 17 connected to the spreader, which engage heart tissue via friction. The members have at least three positions each. The actuator knob is controlled by the clinician. With respect to claim 3, when inserted into the body, the members 15 and 17 are in the configuration shown in figure 3A. Hence, when they move, they move apart in a substantially parallel method. With respect to claim 11, the first position is spaced apart by less than 15 mm. The arm is fixable to a trocar or to an operating table (see column 12, lines 34-50). With respect to claim 18, since the coupling surface is friction, Vierra anticipates claim 18, as it need not show the suction features. Claims 22-26, 28, 30, and 31 are rejected for the reasons given above. Claims 32-35, 37, and 39-50 are rejected in that Vierra also teaches the recited method.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 27, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Furnish. Furnish shows a hand lever actuator for forceps. Hence, it would have been obvious to modify Vierra to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

Claims 7, 29, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Garrison et al. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify Vierra to use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Hossain et al. Hossain et al shows an identical device to Vierra that has a variable joint 40 controllable by knob 42. Such a joint allows better conformance of the device to the heart. Hence, it would have been obvious to modify Vierra et al to use such a joint, to allow a better fit onto the surface of the heart.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Green II et al, Rogers et al, and Boone et al show similar devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone


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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RLN
April 19, 2004

Robert L. Nasser
Primary Examiner
Art Unit 3736



ROBERT L. NASSER
PRIMARY EXAMINER